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10/764,194	01/23/2004	Roberto Edmundo Pazmino Sanchez	14402/1	8062
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EXAMINER				
LAUX, JESSICA L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,194

Applicant(s)SANCHEZ, ROBERTO EDMUNDO
PAZMINO**Examiner**

JESSICA LAUX

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,9 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,9,11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|--|---|

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 11/26/08 have been fully considered but they are not persuasive.

In response to applicant's arguments that Jazzar does not disclose multiple portable precast modules, examiner directs applicant's attention to the disclosure of Jazzar, and particularly to Col 5 where Jazzar expressly discloses multiple precast modules (where precast modules are inherently portable as they are cast off-site of their ultimate destination, distinguishing them as precast modules and not cast in-situ modules),

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and depending are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new matter includes "triangular" indentations; triangular was not described in the specification or shown in the drawings in such a way as to reasonably convey such a feature to one skilled in the relevant art. Accordingly the claims will be examined as best understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 9, 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jazzar (7121061) in view of Reay (5671582).

Regarding claims 1 and 9, 20 (as best understood in view of the above noted new matter): Jazzar a modular building system comprising:

(a) multiple portable precast modules (16 or 17), wherein each of the multiple modules comprise:

- (i) structural steel mesh (28);
- (ii) cementitious mortar encasing the structural steel mesh (figures 2 or 9);
- (c) reinforcing steel mesh (the cross bars as shown at 28).

Jazzar does not expressly disclose indentations located along edges of the module, exposing portions of the structural steel mesh or metal plate connectors, but instead discloses that the reinforcing is exposed for connection to an adjacent module.

Reay discloses cementitious panels having indentations (6) exposing portions of structural steel mesh and metal plate connectors (30) which are connected to said exposed portions of said structural steel mesh thereby connecting adjacent modules (Col. 3, lines 6-14).

It would have been obvious at the time the invention was made to modify the connection design of Jazzar to have exposed portion of structural steel mesh connected with plate connectors to create a strong and secure connection that is available for use in various applications.

Further it is noted that both references disclose designs and methods for connecting adjacent pre-cast panels with reinforcing and it has been held that the substitution of one know element or method for another would be obvious if it yields predictable results; in the instant case the substitution of the connection system of Jazzar for that of Reay yields the predictable results of a securely connected pre-cast panel with reinforcing.

It should be noted that the limitation of "said metal plate connectors are welded to" of claim 1 and "soldered...tied" of claim 9 are considered product-by-process limitations in an apparatus claim. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985). In the instant case applicants claimed product is the same as or

obvious over Jazzar in view Reay as the final product of a panel with steel mesh and plate connectors for connecting exposed product of the mesh does not depend on welding for connecting the steel plate to the mesh; nor does it depend on how the reinforcing and structural mesh were connected.

Regarding claim 2: Jazzar in view of Reay discloses the modular building system of claim 1 above, and further discloses that each module includes a 90 degree appendix on opposite edges of the module (see Jazzar figures 2,9).

Regarding claims 3, 21: Jazzar in view of Reay disclose the modular building system of claim 1 above, but do not expressly disclose epoxy resin on the edges of the module in contact with an adjacent module. However, Jazzar does disclose adding concrete (cementitious mortar) between adjacent modules for connecting (Col. 3, lines 42-46). Further applicant discloses in the specification, paragraph 0044 that one of ordinary skill in the art would recognize that other bonding materials may be used. Based upon the level of common sense and ordinary skill in the art and applicants own disclosure it appears that it would have been obvious to substitute epoxy resin for concrete, for cost and availability considerations, to achieve the predictable results of securely connecting adjacent modules.

Regarding claim 11: The modular building system of claim1, wherein the module is one of a square, rectangle, triangle and trapezoid (see Jazzar figures).

Regarding claims 12, 13: Jazzar in view of Reay disclose the modular building system of claim 1 but are silent regarding the specific design parameters of the structural steel mesh. However, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to select a structural steel mesh having a yield stress between 4000 and 6000 kt/cm² or a diameter of 4mm and a spacing of 100mm x 50mm x 100mm x 100mm, to achieve the desired strength to meet the loads imposed on the panel, since it has been held to be within the general skill of a worker in the art to select a known material (in the instant case the desired steel bars) on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 14, 15, 19: Jazzar in view of Reay discloses the modular building system of claim 1, but does not expressly disclose dimensions of the module. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to design the module to have an overall dimension of 1500mm x 250mm or 750mm x 250mm and a thickness of 40mm to accommodate the desired function of the building while meeting the strength and load requirements imposed on the panel, since it has been held to be within the general skill of a worker in the art to select a certain design or size on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claims 16, 17: Jazzar in view of Reay discloses the modular building system of 2 as above, but does not expressly disclose the dimensions of each 90 degree appendix. However, applicant has not disclosed that the claimed dimensions provide an advantage or solve a stated problem. Furthermore it appears that the appendices of Jazzar and applicants claimed appendices would perform the same function of strengthening the module and providing a secure connection means equally

well. Further it is noted that the modules of Jazzar and applicant's claimed invention are for the purposes of building structures, and therefore would be subject to size limitations and requirements based on the design and function of the building, and that these limitations would vary depending upon the loads subjected to the modules. Therefore it appears to be a mere matter of design choice that would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the appendices of Jazzar to have the claimed dimensions.

Regarding claim 18: Jazzar in view of Reay disclose the modular building system as in claim 1 above, but do not expressly disclose the claimed cementitious mixture. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a cementitious material design to achieve the desired strength to meet the loads imposed on the panel, since it has been held to be within the general skill of a worker in the art to select a known material (in the instant case the cementitious material) on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/J. L./
Examiner, Art Unit 3635